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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/977,404

10/16/2001

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EXAMINER

SHEIKH, ASFAND M

ART UNIT

PAPER NUMBER

3627

MAIL DATE

DELIVERY MODE

07/17/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/977,404

Applicant(s)

YOKOYAMA ET AL.

Examiner

Asfand M. Sheikh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 May 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 10-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 10-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

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DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 01-May-2007 has been entered.

Acknowledgements

2. Claims 1-5 and 10-13 are pending for examination. Claims 1, 5, 10, 11, and 12 have been amended. Claim 13 has been added. The examiner notes new grounds of rejection are established.

Claim Rejections - 35 USC § 103

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 1, 5, 10, 11, 12, and 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Oran in view of Miglautsch.

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As per claim 1, Oran teaches transmitting, to a first terminal at an existing customer of business, a first e-mail requesting an introduction of a new customer-to-be for the business to acquire new customers through a Web site, based on the information on the existing customer registered in a file (see at least, col. 3, lines 44-50 and lines 60-62); registering the information on the existing customer to a second file when receiving and application from the existing customer and identifying the existing customer as an introduce of a new customer (see at least, col. 3, lines 53-59); registering information of the new customer to a third file when the new customer places an order through the Web site according to the information on the business (see at least, col. 3, lines 64-67 and col. 4, lines 1-3 and lines 16-29; Examiner interprets "accepting the invitation to apply" to be analogues to placing an order); and transmitting a third e-mail requesting an introduction of another new customer-to-be for the business to the second terminal when identifying the new customer as another existing customer after checking the third file, the identified new customer being required to purchase products of the business prior to transmitting the third email (see at least, col. 3, lines 44-50 and lines 59-62 and 64-67 and col. 4, lines 1-3 and lines 16-29; Examiner interprets "accepting the invitation to

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apply" to be analogues to required to purchase products of the business prior to transmitting the third email); and wherein the information of the existing customer in the second file is checked with the information on the new customer in the third file when the order is received from the second terminal (col. 2, lines 9-24 and col. 3, lines 44-50 and lines 60-62)

Oran fails to explicitly teach transmitting, to the first terminal, a second e-mail to be transferred to a second terminal of the new customer, the second e-mail including information on the business.

Miglautsch teaches transmitting, to a first terminal a second email to be transferred to a second terminal of the new customer, the second e-mail including information on the business (see at least, Abstract).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Oran to include transmitting, to a first terminal a second email to be transferred to a second terminal of the new customer, the second e-mail including information on the business as taught by Miglautsch. One of ordinary skill in the art would have been motivated to combine the teachings in order to provide messages tailed to personal interests and

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characteristics of the new customer in order to lead a more effective marketing method (see at least, col. 2, lines 9-26).

As per claims 5, 10, 11, 12, and 13, the Examiner notes the claims 5, 10, 11, 12, and 13 are substantially similar to that of claim 1, and thus are rejected accordingly.

5. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Oran in view of Miglautsch as applied to claim 1 above, and further in view of Perri.

As per claim 2, the examiner notes the combination Oran in view of Miglautsch fails to teach further comprising providing an incentive to the existing customer when the new customer places an order through the Web site.

Perri teaches further comprising providing an incentive to the existing customer when the new customer places an order through the Web site (see at least, abstract, 0058, and 0073).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination Oran in view of Miglautsch to include further comprising

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providing an incentive to the existing customer when the new customer places an order through the Web site as taught by Perri. One of ordinary skill in the art would have been motivated to combine the teachings in order to properly identify and correlate referrers to their respective customers (see at least, 0018).

6. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Oran in view of Miglautsch as applied to claim 1 above, and further in view of Huang et al.

As per claim 3, the examiner notes the combination Oran in view of Miglautsch fails to teach wherein the second e-mail is transferred to an e-mail address selected from an e-mail address book of the first terminal.

Huang discloses wherein the second e-mail is transferred to an e-mail address selected from an e-mail address book of the a terminal (see at least, 0074).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination Oran in view of Miglautsch to include wherein the second e-mail is transferred to an e-mail address selected from an e-mail address book of the a terminal as taught by Huang. One of

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ordinary skill in the art would have been motivated to combine the teachings in order to provide an easier way to locate and find contact information related to a customers acquaintances.

7. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Oran in view of Miglautsch as applied to claim 1 above, and further in view of Hare et al..

As per claim 4, the examiner notes the combination Oran in view of Miglautsch fails to teach wherein the information about the existing customer is input at the second terminal.

Hare teaches wherein the information about the existing customer is input at the second terminal by the new customer (see at least, 0029-0031).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination Oran in view of Miglautsch to include wherein the information about the existing customer is input at the second terminal by the new customer as taught by ^{Hare et al.}~~Huang~~. One of ordinary skill in the art would have been motivated to combine the teachings in order to provide the ability to correctly track the which customers are associated with new customers.

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Response to Arguments

8. Applicant's arguments with respect to claims 1-5 and 10-13 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Multi-layer Surveying Systems and Methods with Multi-Layer Incentives [6,446,044] and Method For Automated Electronic Mail Communication [6,993,489].

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Asfand M. Sheikh whose telephone number is (571) 272-1466. The examiner can normally be reached on M-F 8a-4:30p.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ryan M. Zeender can be reached on (571) 272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Asfand M Sheikh
Examiner
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ams
9-Jul-07

 7/9/07
F. RYAN ZEENDER
SUPERVISORY PATENT EXAMINER